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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
UBER, NATHAN C				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/706,952

**Applicant(s)**

GREENBERG ET AL.

**Examiner**

NATHAN C. UBER

**Art Unit**

4143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☒ Claim(s) 5, 15, 19, 20, 30, 35 and 45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 24 February 2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Status of Claims

1. This action is in reply to the application filed on 14 November 2003.
2. Claims 1-45 are currently pending and have been examined.

### Information Disclosure Statement

3. The Information Disclosure Statement filed on 24 February 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### Specification

4. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

### Claim Objections

5. Claims 5, 20 and 35 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 5, 20 and 35 depend from claims 4, 19 and 34, which depend from the independent claims 1, 16 and 31 respectively. The independent claims set forth *managing a financial account for a customer* which necessitates the existence of a financial account and a customer. "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim" (37 CFR 1.75(c)). Here claims 5, 20 and 35 properly incorporate by reference the independent claims both in the preamble and by using the limitations *the customer* and *the financial account* referring back to those limitations in the independent claims. However, claims 5, 20 and 35 include two limitations *soliciting the customer to open the financial account...* and *opening the financial account...* which contradict the premise that the financial accounts and customers exist in the

independent claims. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

6. Claim 19 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 19 improperly references *the method of claim 16*... Here claim 16 defines a system and does not contain a method. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form.
7. Claims 15, 30 and 45 are objected to because of the following informalities: the word "one" is misspelled in the phrase *at least one of a...* Appropriate correction is required.

#### **Claim Rejections - 35 USC § 112**

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-3, 5-8, 11-12, 16-18, 20-23, 26-27, 31-33, 35-38, and 41-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with limitations for which there is insufficient antecedent basis. For example the independent claims contain the limitations *the detected non-credit behavior* and *the determined reward*. It is clear from preceding limitations that *non-credit behavior* is to be detected and *rewards* determined, however use of the word *the* calls the reader's attention to a particular behavior or reward rather than referencing behaviors and rewards generally. Because there is no antecedent basis for a particular reward or behavior the claim is indefinite. Below is a list of additional terms within the claims that lack antecedent basis.

- Credit-risk
- Frequency
- Interest rate

Art Unit: 4143

- Credit limit
- Benefit
- Performance

**Claim Rejections - 35 USC § 101**

10. Claims 31-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The *computer-readable medium on which is stored a set of instructions for managing a financial account* of Claim 31 is not a process, machine, manufacture, or composition of matter, or any improvement thereof. Replacing *computer-readable medium on which is stored a set of instructions for managing a financial account* with "a computer-executable program tangibly embodied on a computer readable medium" is a suggestion for how to bring this claim into compliance with 35 U.S.C. 101 because "a computer-executable program tangibly embodied on a computer readable medium" is statutory subject matter.

**Claim Rejections - 35 USC § 103**

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 4143

13. Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (U.S. 2002/0116266) in view of Walker et al. (6,018,718) and in view of **Official Notice**.

**Claims 1, 16 and 31:**

Marshall, as shown, discloses the following limitations:

- *detecting non-credit behavior of the customer, the non-credit behavior associated with and benefiting an enterprise* (see at least ¶0031, "...individuals accumulate time points by engaging in activities specified by the programs..." and ¶0035, "...such activities may include... attending in person or remotely sales presentation, providing blood donations... engaging in volunteer activities, or a range of other activity which may be desired"),
- *determining a reward associated with the financial account based on the detected non-credit behavior; and* (see at least ¶0031, "[a]n account associated with the individual is provided with accumulated time points when a desired activity is performed" see also ¶0005, describing a lack of incentive for early credit card account payments in the prior art, and ¶0006 calling for incentives for "desirable behaviors" such as early payments to credit card accounts),

Examiner interprets *a reward associated with financial account* as described in ¶¶038-039 which explains that a reward or benefit may directly or indirectly affect an account and may comprise non-monetary units such as points or frequent flyer miles that accumulate in a *bucket*.

- *notifying the customer of the determined reward* (see at least Figure 7, item 800, "listing of various rewards are made available to individual"),

Marshall does not fully disclose *a financial account* as contemplated in ¶¶038, *a credit card account, a financial loan, a checking account, a savings account, or a stock fund*, however, Walker, as shown, more fully discloses a method of awarding particularly financial accounts:

- *financial account* (see at least column 1, lines 5-6),

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the financial account reward method of Walker with the reward system of Marshall because Marshall suggests that service providers such as credit card companies and utilities could benefit from desirable behaviors such as early account payments (see ¶005) and Walker enables a method for applying such rewards program to such accounts.

**Claim 2, 17 and 32:**

The combination Marshall/Walker discloses the limitations in the rejections above. Marshall further discloses evaluating the account balance of a customer to determine eligibility for a reward (see at least ¶0097). Marshall does not disclose the following limitation, however, Walker, as shown, does:

- *evaluating the credit risk of the financial account based upon the frequency at which the non-credit behavior is detected* (see at least column 7, lines 34-36, scores are “currently” used to determine the credit risk of a customer),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the methods disclosed by Walker to be generally known in the art (i.e. evaluating the credit risk of customers based on non-credit behavior such as replying to advertisements) to obtain information about a customer because Marshall teaches providing meaningful inventive to customers to try to influence desirable *non-credit behavior* and being able to predict a customers actions based on Walker's scores helps one practicing the Marshall invention to develop meaningful incentives for the customer and perhaps avoid customers that are not desirable.

**Claim 3, 18 and 33:**

The combination Marshall/Walker discloses the limitations in the rejections above. Further, Marshall, as shown, discloses the following limitations:

Art Unit: 4143

- *if the frequency at which the non-credit behavior is detected attains a certain threshold, providing for the financial account at least one of* (see at least ¶0095, "threshold levels create tangible reward thresholds that individuals can strive to reach in order to become entitled to select a specific reward offered..."),
- *a waiver of an annual fee, a credit redeemable for products, and a credit redeemable for services* (see at least ¶0015, discounted services, and ¶0031, "time points may be redeemed for products and/or services..."),

Marshall does not disclose the following limitations, however, Walker, as shown, does:

- *an interest rate lower than the interest rate prior to the evaluation, a credit limit higher than the credit limit prior to the evaluation, a monetary credit* (see at least column 9, Table II),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the rewards of Walker with the rewards of Marshall because Marshall teaches providing meaningful incentives to customers.

**Claim 4, 19 and 34:**

The combination Marshall/Walker discloses the limitations in the rejections above. Further, Marshall, as shown, discloses the following limitations:

- *arranging a relationship with the enterprise* (see at least ¶0033, "[t]he program may be maintained by a program administrator [m]ultiple participant organizations may engage in interactions, while the program administrator engages various tasks described below..."),

Marshall does not specifically call for arranging a relationship between the administrator of the invention and the participant organizations/enterprises; however Marshall extensively details how participants may communicate accumulation sessions, transfer information required by the "participant database," and transfer individual information to the system. Some sort of relationship must exist between the parties at the very least to



facilitate the communication of data. Since a relationship necessarily exists, a relationship is inherent to the Marshall invention. It is also inherent that the relationship was arranged because business relationships are not naturally occurring phenomenon and must be called into existence by mutually interested parties.

**Claim 5, 20 and 35:**

The combination Marshall/Walker discloses the limitations in the rejections above. Marshall does not disclose the following limitation:

- *making an offer to the enterprise, the offer comprising offering to provide the benefit to the financial account in exchange for the customer engaging in the non-credit behavior*

However, examiner takes **Official Notice** that it is old and well known in the art that business entities or service providers seeking to enter business relationships with other entities or attract participants accomplish this goal, at least initially, by presenting an offer to the perspective participant, such an offer detailing the nature of the business venture proposed.

Further Marshall, as shown, discloses the following limitations:

- *receiving an acceptance of the offer from the enterprise, the acceptance including contact information of the customer* (see at least Figure 2, Item 215 shows the participant transmitting the customer's information to the system and Item 225 shows a third party transmitting the customer's information to the system),
- *soliciting the customer to open the financial account based upon the contact information; and* (see at least ¶0113, "[i]f the program determines that the individual is not an existing enrolled member, the individual is offered the option of enrolling in the program..."),

Art Unit: 4143

- *opening the financial account based upon a response to the solicitation* (see at least ¶113, the individual/customer enrolls in the program by transmitting necessary enrollment information),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to offer the services of the Marshall invention to perspective participants because those practicing the Marshall invention are in a better position to make the initial contact because they conduct the methods and systems of the invention and perspective participants may not otherwise know the service exists.

**Claim 6, 21 and 36:**

The combination Marshall/Walker discloses the limitations in the rejections above. Further, Marshall, as shown, discloses the following limitation:

- *providing for the financial account at least one of a waiver of an annual fee, a credit redeemable for products, and a credit redeemable for services* (see at least ¶0015, discounted services, and ¶0031, "time points may be redeemed for products and/or services..."),

Marshall does not disclose the following limitations, however, Walker, as shown, does:

- *an interest rate lower than the interest rate prior to the evaluation, a credit limit higher than the credit limit prior to the evaluation, a monetary credit* (see at least column 9, Table II),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the rewards of Walker with the rewards of Marshall because Marshall teaches providing meaningful incentives to customers.

**Claim 7, 22 and 37:**

The combination Marshall/Walker discloses the limitations in the rejections above. Marshall does not disclose the following limitation:

- *making an offer to the enterprise, the offer comprising offering to provide the benefit to the financial account in exchange for the customer engaging in the non-credit behavior*

However, examiner takes **Official Notice** that it is old and well known in the art that business entities or service providers seeking to enter business relationships with other entities or to attract participants accomplish these goals, at least initially, by presenting an offer to the perspective participant detailing the nature of the business venture proposed.

Further Marshall, as shown, discloses the following limitations:

- *receiving an acceptance of the offer from the enterprise, the acceptance including contact information of the customer* (see at least Figure 2, Item 215 shows the participant transmitting the customer's information to the system and Item 225 shows a third party transmitting the customer's information to the system),
- *associating the financial account with the enterprise if the customer is currently a customer of an institution controlling the financial account based upon the contact information* (see at least ¶0113, "[t]he information is received by the system and evaluated by the software program to determine whether the individual is an existing enrolled member"),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to offer the services of the Marshall invention to perspective participants because those practicing the Marshall invention are in a better position to make the initial contact because they conduct the methods and systems of the invention and perspective participants may not otherwise know the service exists.

**Claim 8, 23 and 38:**

The combination Marshall/Walker discloses the limitations in the rejections above. Marshall, as shown, further discloses the following limitation:

Art Unit: 4143

- *receiving a voucher subsequent to the performance of the non-credit behavior* (see at least Figure 5, Items 600 and 635, participant system records individual accumulation session values and sends them to the program administrator).

**Claim 9, 24 and 39:**

The combination Marshall/Walker discloses the limitations in the rejections above.

Marshall, as shown, further discloses the following limitation:

- *receiving the voucher from the enterprise* (see at least Figure 5, Items 600 and 635, participant system records individual accumulation session values and sends them to the program administrator).

**Claim 10, 25 and 40:**

The combination Marshall/Walker discloses the limitations in the rejections above.

Marshall, as shown, further discloses methods and a system equivalent to the limitation below:

- *receiving the voucher from the customer* (see at least ¶0075, explaining (with reference to Item 180 of Figure 1) how customers that are not previously enrolled are presented with a unique code that identifies their participation in a credit-worthy activity, the customer then provides this code to the program administrator during enrollment to obtain the credit earned, see also Figure 11, particularly Item 1340, in which individuals initiate accumulation sessions/activities on their own by accessing the system, see also ¶0072, describing a checkpoint system that individuals activate to alert the system of their presence/behavior).

**Claim 11, 26 and 41:**

- *receiving an electronic file subsequent to the performance of the non-credit behavior* (see at least Figure 5, Items 600 and 635, participant system

records individual accumulation session values and sends them to the program administrator),

- *the electronic file comprising a description of the non-credit behavior and an identification of the customer, the identification of the customer obtained by reading an indicia presented by the customer (see at least ¶¶0074, individuals provide identification information to the participant electronically, and it is recorded by the system and stored along with a record of the task completed and any previously completed and recorded tasks, see also ¶¶0054 "the system may issue the individual a unique alphanumeric identification code...").*

**Claim 12, 27 and 42:**

The combination Marshall/Walker discloses the limitations in the rejections above.

Further, Marshall, as shown, discloses the following limitation:

- *providing for the financial account at least one of a waiver of an annual fee, a credit redeemable for products, and a credit redeemable for services (see at least ¶¶0015, discounted services, and ¶¶0031, "time points may be redeemed for products and/or services..."),*

Marshall does not disclose the following limitations, however, Walker, as shown, does:

- *an interest rate lower than the interest rate prior to the evaluation, a credit limit higher than the credit limit prior to the evaluation, a monetary credit (see at least column 9, Table II),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the rewards of Walker with the rewards of Marshall because Marshall teaches providing meaningful incentives to customers.

**Claim 13, 28 and 43:**

The combination Marshall/Walker discloses the limitations in the rejections above.

Further, Marshall, as shown, discloses the following limitation:

Art Unit: 4143

- *using at least one of e-mail, voice mail, facsimile, mail, an item delivery service, Internet, telephone, diskettes, CD ROM, and an interactive voice response system (IVR) (see at least ¶0060, telephone interactions and internet interactions).*

**Claim 14, 29 and 44:**

The combination Marshall/Walker discloses the limitations in the rejections above.

Marshall does not disclose the following limitations, however, Walker, as shown, does:

- *the financial account comprises at least one of a credit card account, a financial loan, a checking account, a savings account, and a stock fund (see at least column 3, line 17, the preferred embodiment of this invention is a credit card account),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the financial account reward method of Walker with the reward system of Marshall because Marshall suggests that service providers such as credit card companies and utilities could benefit from desirable behaviors such as early account payments (see ¶005) and Walker enables a method for applying such rewards program to such accounts.

**Claim 15, 30 and 45:**

The combination Marshall/Walker discloses the limitations in the rejections above.

Further, Marshall, as shown, discloses the following limitation:

- *the enterprise comprises at least on of a charity, a religious organization, a civic club, a professional organization, a school, a university, a sports organization, a political organization, a government agency, a private corporation, and a public corporation (see at least ¶0035, describing various examples of participants including blood donor organizations, utility providers, and other service providers like prepaid phone providers).*

Art Unit: 4143

### **Conclusion**

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- Marshall, US 2003/0233278, tracking and awarding incentives for activities.
  - Danther, US 2003/0130888, a similar inventive system geared specifically towards volunteers in online fundraising campaigns.

Art Unit: 4143

15. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A Reagan** can be reached at **571.270.6710**.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
17. Any response to this action should be mailed to:

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**Washington, D.C. 20231**

or faxed to **571-273-8300**.

18. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 4143

29 February 2008

/James A. Reagan/Supervisory Patent Examiner, Art Unit 4143